

REMARKS

By the above amendment, Applicant has amended claims 1 and 12, and has cancelled claim 9 without prejudice or disclaimer. Upon entry of this amendment, claims 1-8 and 10-12 will remain pending in this application.

In the Office Action dated September 18, 2006, the Examiner: rejected claims 1-11 under 35 U.S.C. § 103(a) as being unpatentable over International Publication No. (WO 97/15009) to Bajpai ("Bajpai") in view of U.S. Patent No. 5,111,384 to Aslanian et al., ("Aslanian"); and rejected claim 12 under 35 U.S.C. § 102(b) as being anticipated by Bajpai.

Applicant respectively traverses the rejections presented in the September 18, 2006 Office Action in light of the newly amended claims and requests allowance of the present application.¹

I. Rejection of claims 1-11 under 35 U.S.C. § 103(a)

Initially, Applicant notes that claim 9 has been cancelled and the rejection of this claim is thus moot.

Applicant respectfully traverses the rejection of claims 1-8 and 10-11 under 35 U.S.C. § 103(a) in light of the current amendments because no *prima facie* case of

¹ As Applicant's remarks with respect to the Examiner's rejections are sufficient to overcome these rejections, Applicant's silence as to certain assertions or requirements applicable to such rejections (e.g., whether a reference constitutes prior art, motivation to combine references, etc.) is not a concession by Applicant that such assertions are accurate or such requirements have been met, and Applicant reserves the right to analyze and dispute such in the future.

obviousness has been established. As M.P.E.P. § 2142 states, “[t]he Examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.”

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). M.P.E.P. § 2142, 8th Ed., Rev. 5 (August 2006), p. 2100-125, 126.

Each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. § 2143.

Here, no *prima facie* case of obviousness has been established for at least the reason that the cited references fail to teach or suggest each and every element of independent claim 1.

Amended claim 1 calls for a combination, including “a knowledge module that stores knowledge representations and distinguishes contexts that are predefined sets of knowledge representations”. In rejecting this element (previously presented as part of dependent claim 9), the Examiner cites Bajpai page 7: ll. 1-16 and Figure 3.

Bajpai is directed towards remotely diagnosing a data processor. The cited portion states, in part: “[a] decision node is a point where a question is posed (e.g., regarding the status of the digital data processor 10) and from where execution flows based on the answer to that question.” (Bajpai page 7: ll. 12-14, emphasis added).

According to the Examiner, "the decision nodes are interpreted as predefined contexts." (Office Action, page 5, lines 17-18). Applicant respectfully traverses the Examiner's position.

"A decision node" does not constitute "predefined contexts" as the Examiner alleges because, "[a] decision node is a point where a question is posed" (Baipai page 7: ll. 12-14, emphasis added). This is not the same as the claimed contexts where the "knowledge module... distinguishes contexts that are predefined sets of knowledge representations", as recited in claim 1 (emphasis added).

Applicant's disclosure specifically cites examples of contexts. "Preferably, context is selected from the group of: system and program performance, background processing, OCS and patches, data dictionary, printer problems, remote function calls and connectivity, R/3 reporting, and security and administration." (Applicant's disclosure, page 31: ¶ 0157). It is clear that Baipai does not teach contexts as claimed.

Elsewhere, Baipai states: "[t]he decision nodes 42-46 include functionality for invoking programs, i.e., "instrumentation," that carry out tests on the digital data processor 10 and return information that facilitates further diagnosis." (Baipai, page 7: ll. 17-19, emphasis added). Applicant submits that, "invoking programs" to "carry out tests" and "return information" does not constitute "contexts that are predefined sets of knowledge representations", as required by claim 1.

In the event that the current grounds of rejection are maintained, Applicant respectfully requests that the Examiner specifically cite where Baipai teaches or

suggests “a knowledge module that stores knowledge representations and distinguishes contexts that are predefined sets of knowledge representations”.

Furthermore, Aslanian fails to cure the deficiencies of Bajpai. That is, Aslanian fails to teach or suggest, “a knowledge module that stores knowledge representations and distinguishes contexts that are predefined sets of knowledge representations”, as required by claim 1. Therefore no *prima facie* case of obviousness has been established with respect to claim 1, and the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

Claims 2-8, and 10-11 each depend from claim 1 and thus require all elements thereof. As set forth above, both Bajpai and Aslanian fail to teach or suggest each and every element of claim 1. Therefore, Bajpai and Aslanian fail to establish a *prima facie* case of obviousness with respect to claims 2-8 and 10-11.

II. Rejection of claim 12 under 35 U.S.C. § 102(b)

Independent claim 12, although different from claim 1, contains language similar to that cited above with respect to claim 1. That is, claim 12 recites, “wherein the context classes are predefined sets of knowledge representations.” Therefore Bajpai and Aslanian fail to teach each and every element of claim 12, including the claimed contexts, and there is no anticipation of the claimed invention. Accordingly, the rejection of claim 12 under 35 U.S.C. § 102(b) is improper and should be withdrawn.

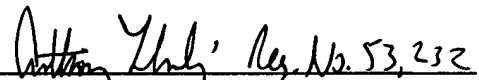
In view of the foregoing, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: November 20, 2006

By: 
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